

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-6, 8, and 10-21 under 35 U.S.C. § 103(a) as being unpatentable over Template Software product line ("SNAP") in view of U.S. Patent No. 5,872,973 to Mitchell et al. ("*Mitchell*").

Applicants propose adding claims 22 and 23. Upon entry of this amendment, claims 1-6, 8, and 10-23 will be pending in this application.

Applicants respectfully traverse the rejection of claims 1-6, 8, and 10-21 under 35 U.S.C. § 103(a) as being unpatentable over SNAP in view of *Mitchell*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original)*.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art." *M.P.E.P.* § 2141(II). Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." *M.P.E.P.* § 2141(III).

The Examiner seems to allege that *Mitchell* discloses "enabling a user to refactor a copied one of the development objects to modify a key attribute of the copied one of the development objects," as recited in claim 1 (Final Office Action at page 4). This is not correct.

Mitchell discloses "[c]reating dynamic connections through the edit process creates links between objects . . . without compromising independence of the objects involved" (col. 23, line 66 - col. 24, line 2). *Mitchell* further discloses "[i]f the user chooses to create an external object connection, he must specify the other type of object to connect to. The simple task is accomplished by choosing the type from a list of all the types" (col. 24, line 65 - col. 25, line 1). Fig. 4 of *Mitchell* illustrates a dialog that is presented to a user for building a "list of semantic links that make up this connection" between two objects (col. 25, lines 7-10). However, creating "an external object connection" does not constitute or suggest "refactor[ing] a copied one of the development objects to modify a key attribute of the copied one of the development objects," as recited in claim 1.

Mitchell also discloses “internal object mapping for the object itself” (col. 25, lines 19-20). “An internal object mapping can be thought of as a special case of an external object mapping where the other object is the same instance (and of course the same type as) the first 65 object being connected” (*Mitchell* at col. 26, lines 62-64). “Internal object mapping,” as taught by *Mitchell*, also does not constitute or suggest “refactor[ing] a copied one of the development objects to modify a key attribute of the copied one of the development objects,” as recited in claim 1.

In view of the mischaracterizations of at least the *Mitchell* reference, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Accordingly, the Examiner has failed to clearly articulate a reason why claim 1 would have been obvious to one of ordinary skill in the art in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 12 and 19 though of different scope than claim 1, recite similar elements, and are thus allowable over *SNAP* and *Mitchell* for at least the same reason as claim 1. Claims 2-6, 8, 10, 11, 13-18, 20, and 21 depend from claims 1, 12, and 19, and are thus allowable over *SNAP* and *Mitchell* for at for at least the same reasons as claim 1. New claims 22 and 23 depend from claims 1 and 12, respectively, and are thus allowable over *SNAP* and *Mitchell* for at least the same reasons as claim 1.

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. It is

respectfully submitted that the entering of the Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


In view of the foregoing remarks, Applicants requests the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 6, 2008

By: 
Eli Mazour
Reg. No. 59,318
/direct telephone: (202) 408 4320/